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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,905	02/14/2001	Kiyoko Karusawa	14318	3208

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GARDEN CITY, NY 11530

EXAMINER

YUN, EUGENE

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/782,905	Applicant(s) KARUSAWA, KIYOKO	
	Examiner Eugene Yun	Art Unit 2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/2/2004 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Borland (WO 99/26394).

Referring to Claim 9, Borland teaches a portable telephone allowing a call recipient, after detecting a pending incoming call 300 (fig. 4), to respond to the call in a normal-response mode 320 (fig. 4) or to activate an originator-confirmation mode to seek identification of the caller (fig. 10), comprising:

display means for displaying to the call recipient, while the incoming call is pending, a call identifier, if any, of an originator of the received call (see pg. 3, lines 4-5);

an originator-confirmation activator means that is operable by the call recipient,

while the incoming call is pending, to activate the originator-confirmation mode, if the call recipient does not recognize the displayed call identifier or there is no such call identifier displayed (see pg. 14, lines 12-17);

message-sending means which is activated when the call recipient operates the originator-confirmation activator means, the message-sending means upon being activated sending a first message to the call originator prompting a response from the call originator (see pg. 14, lines 31-37); and,

monitor means for outputting to the call recipient a speech signal from the call originator as the response 900 and 920 (fig. 11), wherein the portable telephone allows a call recipient to either:

(i) respond to an incoming call in the normal response mode by responding to the call without activating the originator-confirmation mode (see 320 of fig. 4); or,

(ii) respond to an incoming call by activating the originator-confirmation mode, consider the response from the call originator, and then either terminate the call or respond in the normal-response mode (see pg. 14, lines 28-30).

Referring to Claim 10, Borland also teaches timer means for measuring a predetermined time after the first message is sent, wherein connection of the call originator is terminated if an acceptable response from the call originator is not received within the predetermined time (see pg. 15, lines 5-18).

Referring to Claim 11, Borland also teaches a normal-response activator means for activating a normal-response mode, wherein activation of the normal-response

activator means causes a change from the originator-confirmation mode to the normal-response mode (see 310 of fig. 4).

Referring to Claim 12, Borland also teaches wherein only reception is possible in the originator confirmation mode, and both transmission and reception are possible in the normal-response mode (see pg. 14, lines 21-30).

Referring to Claim 13, Borland also teaches a channel disconnection activation means for forcible immediate disconnection of the originator if an acceptable speech signal from the call originator is not received, the forcible disconnection taking place after the message-sending means has sent a second message to the call originator regarding lack of reception of an acceptable speech signal (see pg. 18, lines 1-5).

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### ***Response to Arguments***

4. Applicant's arguments filed 8/2/2004 have been fully considered but they are not persuasive.


The applicant argues that the Borland reference does not teach the option of simply speaking with the caller after a glance at their display. The examiner disagrees. When referring to Fig. 7 of the Borland reference, there is a caller ID unit which displays the number of the incoming call. When the "no-call" feature is not enabled, as shown in fig. 4, the phone rings like normal thus enabling the user to answer an incoming call just by looking at the caller ID # on the display. Therefore, the Borland reference does teach the limitation of simply speaking with the caller after a glance at their display.

Second, answering a call after glancing at an identification # on a display is very well known in the art and is a feature in the vast majority, if not all cellular phones used today.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Eugene Yun  
Examiner  
Art Unit 2682

EY

  
9/17/07  
LESTER G. KINCAID  
PRIMARY EXAMINER